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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/813,820	03/22/2001	Magnus Hook	P06357US02/BAS	8424

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STITES & HARBISON PLLC
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ALEXANDRIA, VA 22314

EXAMINER

FORD, VANESSA L

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 05/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/813,820

Applicant(s)

HOOK ET AL.

Examiner

Vanessa L. Ford

Art Unit

1645

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 February 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on 11 February 2005. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: NONE.

Claim(s) objected to: NONE.

Claim(s) rejected: 1-16.

Claim(s) withdrawn from consideration: NONE.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☒ Other: Advisory Action Attachment.

LYNETTE R. F. SMITH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Advisory Action Attachment

1. Applicant's amendment filed February 11, 2005 is acknowledged. Claims 1, 7, 9 and 15 have been amended.

Rejection Maintained

2. The Applicant's arguments regarding the rejection of claims 1-16 under 35 U.S.C. 102(b) were addressed on pages 3-4, paragraph 5 of the Final Office Action.

The rejection was on the grounds that the Patti et al teach monospecific antibodies that recognized a recombinant *Staphylococcus aureus* collagen adhesin (see the Abstract and page 4771). Limitations such as "suitable for parental, oral, intranasal, subcutaneous or intravenous administration" and "prevents *S. aureus* infection" are being view as limitations of intended use.

Since the Office does not have the facilities for examining and comparing applicant's antibody with the antibody of the prior art, the burden is on the applicant to show a novel or unobvious difference between the claimed product and the product of the prior art (i.e., that the antibody of the prior art does not possess the same material structural and functional characteristics of the claimed antibody). See In re Best, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and In re Fitzgerald et al., 205 USPQ 594.

Applicant urges that the claims have been amended to the specific M31 regions that the claimed antibody is capable of binding. Applicant urges that the prior art does not teach or disclose the claimed antibody. Applicant urges that they have overcome the art rejection under 102(b) by the amendment. Applicant urges that antibodies that are directed to the full-length collagen binding protein are different from the claimed antibody raised against the M31 subregion of the collagen binding protein. Applicant refers to the Declaration of Dr. Patti filed under 37 C.F.R. 1.131 to support their position.

Applicant's arguments filed February 11, 2005 have been fully considered but they are not persuasive. The amended claims are not limited to antibodies that are specific to subregions of the collagen binding domain. Patti et al teaches antibodies that are "capable of binding" to the specific M31 subregion of the collagen binding protein having the sequence of amino acids 61-343 of the full length collagen binding protein of *Staphylococcus aureus*. It should be remembered that the amended claims recite "an isolated antibody which is capable of binding to the specific M31 subregion of the collagen binding protein having the sequence of amino acids 61-343 of the full length collagen binding protein of *Staphylococcus aureus* ...". There is no requirement or limitation in the claims that the antibody actually binds to the specific M31 subregion of the collagen binding protein. Therefore, the antibody of the prior art is capable of binding to the specific M31 subregion of the collagen binding protein. To address Applicant's comment regarding the Declaration of Dr. Patti, it should be noted that the declaration merely discloses that the antibodies of the prior art and the claimed antibody differ because the antibody of the prior art is directed to the full length collagen binding protein and the claimed antibody is directed to the specific M31 subregion of the collagen binding protein. However, Applicant has provided no side-by-side comparison to show that the claimed antibodies differ from that of the prior art. It is the Examiner's position that the claimed antibodies are the same as the antibodies of the prior art. Therefore, Patti et al anticipate the claimed invention.

Status of Claims

3. No claims allowed.

Conclusion

4. Any inquiry of the general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers relating to this application may be submitted to Technology Center 1600, Group 1640 by facsimile transmission. The faxing of such papers must conform with the notice published in the Office Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for the Group 1600 is (703) 872-9306.

Any inquiry concerning this communication from the examiner should be directed to Vanessa L. Ford, whose telephone number is (571) 272-0857. The examiner can normally be reached on Monday – Friday from 9:00 AM to 6:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached at (571) 272-0864.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Vanessa L. Ford
Biotechnology Patent Examiner
April 26, 2005